



A DOCPHOENIX

APPL PARTS

IMIS _____
Internal Misc. Paper

LET. _____
Misc. Incoming Letter

371P _____
PCT Papers in a 371 Application

A... _____
Amendment Including Elections

ABST _____
Abstract

ADS _____
Application Data Sheet

AF/D _____
Affidavit or Exhibit Received

APPENDIX _____
Appendix

ARTIFACT _____
Artifact

BIB _____
Bib Data Sheet

CLM _____
Claim

COMPUTER _____
Computer Program Listing

CRFL _____
All CRF Papers for Backfile

DIST _____
Terminal Disclaimer Filed

DRW _____
Drawings

FOR _____
Foreign Reference

FRPR _____
Foreign Priority Papers

IDS _____
IDS Including 1449

NPL _____
Non-Patent Literature

OATH _____
Oath or Declaration

PET. _____
Petition

RETMAIL _____
Mail Returned by USPS

SEQLIST _____
Sequence Listing

SPEC _____
Specification

SPEC NO _____
Specification Not in English

TRNA _____
Transmittal New Application

CTNF _____
Count Non-Final

31105/02 CTRS 5
Count Restriction

EXIN _____
Examiner Interview

M903 _____
DO/EO Acceptance

M905 _____
DO/EO Missing Requirement

NFDR _____
Formal Drawing Required

NOA _____
Notice of Allowance

PETDEC _____
Petition Decision

OUTGOING

CTMS _____
Misc. Office Action

1449 _____
Signed 1449

892 _____
892

ABN _____
Abandonment

APDEC _____
Board of Appeals Decision

APEA _____
Examiner Answer

CTAV _____
Count Advisory Action

CTEQ _____
Count Ex parte Quayle

CTFR _____
Count Final Rejection

INCOMING

AP.B _____
Appeal Brief

C.AD _____
Change of Address

N/AP _____
Notice of Appeal

PA.. _____
Change in Power of Attorney

REM _____
Applicant Remarks in Amendment

XT/ _____
Extension of Time filed separate

Internal

SRNT _____
Examiner Search Notes

CLMPTO _____
PTO Prepared Complete Claim Set

ECBOX _____
Evidence Copy Box Identification

WCLM _____
Claim Worksheet

WFEE _____
Fee Worksheet

File Wrapper

FWCLM _____
File Wrapper Claim

IIFW _____
File Wrapper Issue Information

SRFW _____
File Wrapper Search Info



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,458	07/05/2001	Carmen Almansa	1604-129	7335

6449 7590 05/31/2002

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EXAMINER

SAEED, KAMAL A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 05/31/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/807,458

Applicant(s)

ALMANSA ET AL.

Examiner

Kamal A Saeed

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 20-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-13 and 20-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-13 and 20-40 are pending in this application.

This office action supersedes the office action of paper No. 4 which has been entered in the file.

Election/Restrictions

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous variables in the claims, e.g. R^1 , R^2 , R^3 , X, Y etc and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

Group I claim(s) 1-11 drawn in part to compound of the formula I wherein, Y and X are as defined in claim 1, R^1 and R^3 are as defined in claim 1, R^2 is unsubstituted or substituted phenyl or naphthyl, one process for their preparation and one method of use (e.g. treating cancer).

Group II claim(s) 1-11, drawn in part to compound of the formula I wherein, Y and X are as defined in claim 1, R^1 and R^3 are as defined in claim 1, R^2 represents unsubstituted or substituted pyridine, one process for their preparation and one method of use (e.g. treating inflammation).

Group III claim(s) 1-11, drawn in part to compound of the formula I wherein, Y and X are as defined in claim 1, R^1 and R^3 are as defined in claim 1, R^2 represents unsubstituted or substituted pyrazine, pyrimidine or pyridazine, one process for their preparation and one method of use (e.g. treating epilepsy).

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In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhausted, as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same. **If applicant is unable to elect a single invention, applicant may instead choose to elect a specific compound and examiner will attempt to group it.** The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain a (4-methylsulfonylphenyl) imidazole, which does not define a contribution over the prior art. The substituents on the imidazole group vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, the numerous provisos found in the claims, and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.